

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Nowak et al.**

Examiner: **M. Jackson**

Serial No.: **09/178,329**

Group Art Unit: **1794**

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Confirmation No.: **4360**

For: **COMPOSITE WRAP MATERIAL**

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P.O. Box 1450
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Sir:

SECOND APPEAL BRIEF

Pursuant to 37 CFR §41.37, Appellants hereby submit this appeal brief. The appeal brief is being timely submitted under 37 CFR §41.37(a).

Respectfully Submitted,

Date: May 3, 2010

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I. Real Party in Interest

The real party in interest is Coating Excellence International LLC, present owner of the application and the invention described therein.

II. Related Appeals and Interferences

Related U.S. patent application serial no. 10/094,060 was previously on appeal, and is now withdrawn.

III. Status of Claims

Claims 25, 26, 28-35 and 37-58 are pending in the present application. Claims 1-24, 27 and 36 are cancelled; claims 25, 26, 28-35 and 37-58 stand rejected. Claims 25, 26, 28-35 and 37-58 are involved in the Appeal.

Claims 25, 34, 43 and 51 are the only independent claims.

IV. Status of Amendments

No amendments to the claims are made in this Appeal Brief.

V. Summary of Claimed Subject Matter

The present invention relates to composite wrap materials for use as a protective covering in a variety of applications, and methods of making the composite wrap materials. More particularly, the invention relates to composite wrap materials used for packaging paper products. 1:5-8 (References are to the application as filed, by page and line number).

Reams of paper for copy machines, computers, and other applications, are found in retail stores packaged in various composite or non-composite wrap materials. In addition to keeping the paper contained in the package, the wrap provides a moisture barrier that prevents or delays the absorption of moisture by the wrapped paper. The wrap also presents the paper contained inside in an appealing manner to the consumer. 1:11-16.

Conventional commercial wrappers include paper/polyethylene/paper laminates, paper/wax/paper laminates, polyethylene-coated papers, wax-coated papers, and transparent

polymer films. A drawback of paper-based wrap materials is their low burst strength. Often, such packages tend to break open before reaching the consumer because the wrapper is not strong enough to hold the paper upon repeated handling and stacking on store shelves. This not only ruins the product by causing an unsightly appearance on a store shelf, but can damage the paper which can cause copiers and printers to become jammed. 1:17-22; 2:1-2.

A disadvantage of film-based wrap materials that do not contain paper is that they are difficult to run on conventional packaging equipment during the wrapping process and require costly modifications to a paper packaging line. In addition, film-based wrap materials have a low burst strength, and lack the structural support of the heavier paper structures. 2:3-7.

Another disadvantage of known wraps is that they process either like paper or film, depending on their major component. While providing a good dimensionally stable print surface, paper does not provide the gloss or the ink holdout of film structures. Film, while providing gloss and ink holdout, is more flexible and much more difficult to handle than paper due to its stretch properties. 2:8-12.

As store distribution of such paper products has increased, paper companies have wished to improve the graphics on the packaging for greater shelf appeal, and increase the strength of the wrapper to dependably contain a ream of paper until opened by the consumer. 2:13-16.

A problem to be solved by the present invention is to provide a composite wrap material that can be used to wrap a ream of paper or other material to provide a wrapped package having high burst strength. 2:17-21.

Additional problems to be solved by the present invention are to provide:

(1) a composite wrap material that will provide a barrier against moisture absorption by the wrapped contents;

(2) a composite wrap material having the fold characteristics of paper; and

(3) a composite wrap material that can have a high gloss print surface or a standard paper print surface as desired. 2:17-23; 3:1-2.

Claims 25, 34, 43 and 51 are the only independent claims. Claim 25 is as follows:

25. A wrapped ream of paper, comprising:

a laminated composite wrap material including a first layer of paper having an inner surface and an outer surface; a second layer of polymer film material having an outer surface and an inner surface; and an adhesive layer between the inner surfaces of said first and second layers;

wherein said laminated composite wrap material wraps said ream of paper, and the inner surface of said second layer of polymer film material is printed before lamination.

Support for this claim is found in the specification as filed at e.g., page 3, lines 8-19; page 4, lines 21-23; and page 6, lines 21-22 – page 7, lines 1-2.

Claim 34 is as follows:

34. A wrapped ream of paper, comprising:

a laminated composite wrap material including a first layer of paper having an inner surface and an outer surface; a second layer of polymer film material having an outer surface and an inner surface; and an adhesive layer between the inner surfaces of said first and second layers;

wherein said laminated composite wrap material wraps said ream of paper, and the inner surface of said first layer of paper is printed before lamination.

Support for this claim is found in the specification as filed at e.g., page 3, lines 8-19; page 4, lines 21-23; and page 6, lines 21-22 – page 7, lines 1-2.

Claim 43 is as follows:

43. A wrapped ream of paper, consisting of:

a laminated composite wrap material including a first layer of paper having an inner surface and an outer surface; a second layer of polymer film material having an outer surface and an inner surface; and an adhesive layer between the inner surfaces of said first and second layers;

wherein said laminated composite wrap material wraps said ream of paper, and the inner surface of said second layer of polymer film material is printed before lamination.

Support for this claim is found in the specification as filed at e.g., page 3, lines 8-19; page 4, lines 21-23; and page 6, lines 21-22 – page 7, lines 1-2.

Claim 51 is as follows:

51. A wrapped ream of paper, consisting of:

a laminated composite wrap material including a first layer of paper having an inner surface and an outer surface; a second layer of polymer film material having an outer surface and an inner surface; and an adhesive layer between the inner surfaces of said first and second layers;

wherein said laminated composite wrap material wraps said ream of paper, and the inner surface of said first layer of paper is printed before lamination.

Support for this claim is found in the specification as filed at e.g., page 3, lines 8-19; page 4, lines 21-23; and page 6, lines 21-22 – page 7, lines 1-2.

VI. Grounds of Rejection to be Reviewed on Appeal

Whether claims 25, 26, 28-35 and 37-58 were properly rejected under 35 U.S.C. §103(a) as being unpatentable over the admitted prior art in view of Peer Jr.

VII. Argument

1. Rejection of claims 25, 26, 28-35 and 37-58 under 35 U.S.C. §103(a) as being unpatentable over the admitted prior art in view of Peer Jr.: There is no teaching or suggestion in the references, alone or in combination, of a wrapped ream of paper as disclosed and presently claimed, wherein the inner surfaces of either the first layer of paper or the second layer of polymer film material are printed before lamination.

Claims 25, 26, 28-35 and 37-58 were rejected under 35 U.S.C. §103(a) as being unpatentable over the admitted prior art in view of Peer Jr. The following is stated at page 3, paragraph 1 of the Office Action:

“The admitted prior (art) teaches a ream of paper wrapped by a wrapping material comprising a paper layer and polymer and/or wax coating, particularly polyethylene coating, to provide a moisture barrier for the ream of paper (Pages 1-2), but do not teach that the wrapping material is formed from a polymer film adhered to the paper layer with an adhesive and is printed before lamination as in instant Claim 25. However, Peer Jr teach a composite material for packaging comprising a paper substrate laminated to a plastic film via an adhesive layer which provides improved tear resistance and higher strength to the paper composite, wherein the plastic film is preferably transparent to permit reverse printing on the inner surface and provide abrasion resistance to the decoration visible through the film (Abstract; Col. 8, lines 40-60.)”

35 U.S.C. § 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

Please note that Peer Jr. relates to a secondary container packaging material for use in six pack can wraps, six pack bottle carriers, twelve pack carriers, etc., comprising a composite of a paper material laminated to a plastic film. As stated at column 1, lines 10-20 of the reference:

“The term ‘secondary container packaging’ as generally understood in the industry and as used herein refers to packaging used in conjunction with primary containers, such as cans or bottles, which contain the ultimate product, such as beer or other beverages.

Secondary container packaging includes container wraps which surround and support the containers, basket bottle carriers having bottom and side supports for the containers and an upwardly extending handle, 12-pack rectangular carriers completely enclosing the containers, and labels for application to the containers. (emphasis added)

There is no teaching or suggestion in the reference of the applicability of such material for use as primary packaging, i.e., as the packaging actually containing the ultimate product. In the present invention, the laminated composite wrap material wraps the ream of paper, i.e., it serves as the primary packaging for the reams of paper.

It is well established that if a proposed modification or combination of the prior art would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In this case, modifying the invention of Peer Jr. so that the secondary packaging was the only packaging containing the ultimate product (e.g., beverage items) would result in a product unsuitable for its intended purpose. Therefore, prima facie obviousness is not established, and the rejection is overcome.

Furthermore and as previously noted, Finestone et al. (U.S. Pat. No. 5,244,702) at column 2, lines 15-18 states the following: “*B. The paper facing of the laminate sheeting has a high affinity for standard printing inks, so that the products made therefrom can readily be printed and colored.*” (emphasis added) This exemplifies of the state of the prior art, in which printing follows lamination; Appellants respectfully reiterate that they have proceeded contrary to the state of the art in their invention as disclosed and presently claimed. Appellants therefore request that the rejections under 35 U.S.C. §103(a) be withdrawn.

VIII. CLAIMS APPENDIX

1-24. (cancelled)

25. (previously presented) A wrapped ream of paper, comprising:

a laminated composite wrap material including a first layer of paper having an inner surface and an outer surface; a second layer of polymer film material having an outer surface and an inner surface; and an adhesive layer between the inner surfaces of said first and second layers;

wherein said laminated composite wrap material wraps said ream of paper, and the inner surface of said second layer of polymer film material is printed before lamination.

26. (previously presented) The wrapped ream of paper as recited in claim 25, wherein said second layer of polymer film material is selected from the group consisting of polyethylene, polypropylene and polyester.

27. (cancelled)

28. (previously presented) The wrapped ream of paper as recited in claim 25, wherein said adhesive layer comprises a polymer material selected from the group consisting of polyethylene, polypropylene, polyvinylidene chloride, polyethylene acrylic acid, polyester, polyisobutylene, nylon, polymethylpentene, and ethylene vinyl acetate, and copolymers thereof.

29. (previously presented) The wrapped ream of paper as recited in claim 25, wherein the adhesive layer comprises a wax/polymer blend.

30. (previously presented) The wrapped ream of paper as recited in claim 25, wherein the adhesive layer comprises a hot-melt adhesive.

31. (previously presented) The wrapped ream of paper as recited in claim 25, wherein one or more of the layers are pigmented.

32. (previously presented) The wrapped ream of paper as recited in claim 25, wherein the surfaces of the first or second layer comprise a metallized material.

33. (previously presented) The wrapped ream of paper as recited in claim 25, wherein said first and second layers are integrally and continuously bonded together by said adhesive layer.

34. (previously presented) A wrapped ream of paper, comprising:

a laminated composite wrap material including a first layer of paper having an inner surface and an outer surface; a second layer of polymer film material having an outer surface and an inner surface; and an adhesive layer between the inner surfaces of said first and second layers;

wherein said laminated composite wrap material wraps said ream of paper, and the inner surface of said first layer of paper is printed before lamination.

35. (previously presented) The wrapped ream of paper as recited in claim 34, wherein said second layer of polymer film material is selected from the group consisting of polyethylene, polypropylene and polyester.

36. (cancelled)

37. (previously presented) The wrapped ream of paper as recited in claim 34, wherein said adhesive layer comprises a polymer material selected from the group consisting of polyethylene, polypropylene, polyvinylidene chloride, polyethylene acrylic acid, polyester, polyisobutylene, nylon, polymethylpentene, and ethylene vinyl acetate, and copolymers thereof.

38. (previously presented) The wrapped ream of paper as recited in claim 34, wherein the adhesive layer comprises a wax/polymer blend.

39. (previously presented) The wrapped ream of paper as recited in claim 34, wherein the adhesive layer comprises a hot-melt adhesive.

40. (previously presented) The wrapped ream of paper as recited in claim 34, wherein one or more of the layers are pigmented.

41. (previously presented) The wrapped ream of paper as recited in claim 34, wherein the surfaces of the first or second layer comprise a metallized material.

42. (previously presented) The wrapped ream of paper as recited in claim 34, wherein said first and second layers are integrally and continuously bonded together by said adhesive layer.

43. (previously presented) A wrapped ream of paper, consisting of:

a laminated composite wrap material including a first layer of paper having an inner surface and an outer surface; a second layer of polymer film material having an outer surface and an inner surface; and an adhesive layer between the inner surfaces of said first and second layers;

wherein said laminated composite wrap material wraps said ream of paper, and the inner surface of said second layer of polymer film material is printed before lamination.

44. (previously presented) The wrapped ream of paper as recited in claim 43, wherein said second layer of polymer film material is selected from the group consisting of polyethylene, polypropylene and polyester.

45. (previously presented) The wrapped ream of paper as recited in claim 43, wherein said adhesive layer comprises a polymer material selected from the group consisting of polyethylene, polypropylene, polyvinylidene chloride, polyethylene acrylic acid, polyester, polyisobutylene, nylon, polymethylpentene, and ethylene vinyl acetate, and copolymers thereof.

46. (previously presented) The wrapped ream of paper as recited in claim 43, wherein the adhesive layer comprises a wax/polymer blend.

47. (previously presented) The wrapped ream of paper as recited in claim 43, wherein the adhesive layer comprises a hot-melt adhesive.

48. (previously presented) The wrapped ream of paper as recited in claim 43, wherein one or more of the layers are pigmented.

49. (previously presented) The wrapped ream of paper as recited in claim 43, wherein the surfaces of the first or second layer comprise a metallized material.

50. (previously presented) The wrapped ream of paper as recited in claim 43, wherein said first and second layers are integrally and continuously bonded together by said adhesive layer.

51. (previously presented) A wrapped ream of paper, consisting of:
a laminated composite wrap material including a first layer of paper having an inner surface and an outer surface; a second layer of polymer film material having an outer surface and an inner surface; and an adhesive layer between the inner surfaces of said first and second layers; wherein said laminated composite wrap material wraps said ream of paper, and the inner surface of said first layer of paper is printed before lamination.

52. (previously presented) The wrapped ream of paper as recited in claim 51, wherein said second layer of polymer film material is selected from the group consisting of polyethylene, polypropylene and polyester.

53. (previously presented) The wrapped ream of paper as recited in claim 51, wherein said adhesive layer comprises a polymer material selected from the group consisting of polyethylene, polypropylene, polyvinylidene chloride, polyethylene acrylic acid, polyester, polyisobutylene, nylon, polymethylpentene, and ethylene vinyl acetate, and copolymers thereof.

54. (previously presented) The wrapped ream of paper as recited in claim 51, wherein the adhesive layer comprises a wax/polymer blend.

55. (previously presented) The wrapped ream of paper as recited in claim 51, wherein the adhesive layer comprises a hot-melt adhesive.

56. (previously presented) The wrapped ream of paper as recited in claim 51, wherein one or more of the layers are pigmented.

57. (previously presented) The wrapped ream of paper as recited in claim 51, wherein the surfaces of the first or second layer comprise a metallized material.

58. (previously presented) The wrapped ream of paper as recited in claim 51, wherein said first and second layers are integrally and continuously bonded together by said adhesive layer.

IX. EVIDENCE APPENDIX

No additional evidence is attached herewith.

X. RELATED PROCEEDINGS APPENDIX

As set forth above, related U.S. patent application serial no. 10/094,060 was previously on appeal, and is now withdrawn. The related decision is submitted herewith.